

REMARKS

Claims 1 through 11 are pending in this Application. Claim 1 has been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure noting, for example, Fig. 2, page 5 of the written description of the specification, lines 5 through 11, page 14 of the written description, lines 10 through 14, and page 27, lines 1 and 2. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1, 2 and 5 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al.

In the statement of the rejection the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the module disclosed by Takizawa et al. by providing a groove as disclosed by Toyama et al. This rejection is traversed.

There are significant differences between the claimed optical waveguide module and the devices disclosed by each of the references to Takizawa et al. and Toyama et al. that undermine the obviousness conclusion under 35 U.S.C. § 103. These differences are such that even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Specifically, the optical waveguide module defined in independent claim 1 comprises, *inter alia*, a groove in the optical circuit formed such that the reflection filter reflects part of the signal light as the reflected light to the **top surface side of the optical circuit**. Further, the optical waveguide module defined in independent claim 1 comprises a photodetector which is

strategically arranged such that the reflected light is made incident onto a light incident face thereof at a predetermined angle Φ , between the light incident face and the light incident direction, within a range of 80°-90°. Neither of the applied references discloses or suggests such features.

The above argued features of the present invention are functionally significant. This is because the claimed optical waveguide module is structured such that the photosensitivity for the reflected light at the photodetector can be kept approximately constant, regardless of the state of polarization of the signal light. Therefore, the present invention enables accurate monitoring of the optical intensity regardless of the state of polarization of the signal light.

The above argued functionally significant differences between the claimed optical waveguide module and the device disclosed by each of the applied references compels the conclusion that even if the applied references are combined as proposed by the Examiner, and again Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra*.

Applicants, therefore, submit that the imposed rejection of claims 1, 2 and 5 under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 3, 6 and 7 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al. and Kimura;

Claims 4, 8 and 9 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al. and Kukobo et al.;

Claim 10 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al. and Shanley; and

Claim 11 was under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al. and Yamamoto et al.

Each of the above rejections of claims 3, 6 and 7, of claims 4, 8 and 9, of claim 10, and of claim 11 under 35 U.S.C. § 103 is traversed. Specifically, each of claims 3, 4 and 6 through 11 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al. The additional references to Kimura, Kukobo et al., Shanley and Yamamoto et al. do not cure the previously argued deficiencies in the attempted combination of Takizawa et al. and Toyama et al.

Applicants, therefore, submit that the imposed rejections of claims 3, 6 and 7 under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al. and Kimura, of claims 4, 8 and 9 under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al. and Kukobo et al., of claim 10 under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al. and Shanley; and of claim 11 under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Toyama et al. and Yamamoto et al. are not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

Application No.: 10/501,512

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'A. J. Steiner', written over the printed name.

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